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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,296	05/29/2001	Christian Joseph Dederen	P 281137 UQI 50703/USw	6264
909	7590	10/03/2003	EXAMINER	
PILLSBURY WINTHROP, LLP			METZMAIER, DANIEL S	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	
			1712	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/865,296		DEDEREN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Daniel S. Metzmaier		1712	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,7,8,10-16,19-27,34-44 and 48-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,7,8,10-16,19-27,34-44 and 48-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Claims 1-4, 7-8, 10-16, 19-27, 34-44, and 48-67 are pending in the instant application. Claims 5-6, 9, 17-18, 28-33 and 45-47 have been canceled.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 9, 2003 has been entered.

#### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of its filing.

The declaration improperly identifies the foreign application by the incorrect filing date. The proper date appears to be December 5, 1998 (05.12.98) rather than the December 15, 1998 set forth.

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Furthermore, the declaration improperly claims priority for US Application Number 09/452,144, filed 01 December 1999, and US 60/111,440, filed 8 December 1998, under 35 USC 119/365 of any foreign application for patent. Said claim is improper since the US provisional application and the US application filed under 35 USC 111 are not foreign applications for patent. A claim for priority may both be made to said applications under 35 USC 119/365. A proper claim for benefit of the earlier filing date should be made under 35 USC 119(e) for provisional application 60/111,440, filed 8 December 1998. A proper claim for benefit of the earlier filing date should be made under 35 USC 120 for application 09/452,144, filed 01 December 1999.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4, 7-8, 10-16, 19-27, 37-38, 39-43 and 52-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims (claim 1 and 59) define "from 0.02 to 1.5% by weight of the emulsion of an oil emulsifier, wherein the emulsifier comprises one or more non-ionic emulsifier(s)". Said language is confusing and indefinite because the use of "an" defines and/or suggest a single emulsifier while the claims and the specification are also open to an emulsifier package. It is suggested applicants employ the language "from 0.02 to 1.5% by weight of the emulsion of ~~an oil~~ total emulsifier".

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Claims 7, 8, 39-41 employ open language, "comprising", to further define a species of the claim 1 emulsifiers. It is unclear what is the intended scope of said claims. It is unclear whether these are intended to be further ingredients of the emulsifier, which have been defined in the Markush grouping employing closed language in claim 1, or a narrower definition of the species set forth in claim 1.

Attention is directed to M.P.E.P. § 2173.05(h).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 36 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by FMC Corp., CA 2,188,331. FMC '331 (examples 5, 6 and 8E) disclose oil-in-water emulsions of fatty lipids dispersed in water. When the claim body defines a structurally complete invention and the preamble only states a purpose or intended use for the invention, the preamble is not a claim limitation; ***Kropa v. Robie***, 187 F.2d at 152, 88 USPQ2d at 480-81. Furthermore, the emulsions of FMC '331 are disclosed for use in baked goods. Said emulsions are necessarily non-toxic employing emulsified lipids and would have been expected to have use as a personal care or cosmetic composition. Tween 80 is POE(20) sorbitan monooleate, an alkoxylated fatty ester. See page 12, lines 9 et seq, for other nonionic emulsifier.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 34-36, 44 and 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imperial Chemical Industries PLC (hereafter ICI), WO 96/31187, in view of FMC Corporation (hereafter FMC), WO 93/02571. ICI (abstract; page 1, last paragraph et seq; examples and claims) discloses surfactant compositions as solid surfactant dispersions optionally comprising an emollient. ICI (page 4 et seq) desirably employs at least one hydrocolloid and emulsified therein at least one emollient oil. ICI (page 5) teaches hydrocolloids including starches, guar, similar polysaccharides and Xanthan gums. ICI (page 6) teaches concentrations which when employed in the milks, lotions and creams, ie., water concentrations of 55 to 95% by weight would read on the

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instant concentrations. ICI (page 7) further teaches the incorporation of plant extracts.

ICI (examples) teaches combinations of nonionic emulsifiers.

ICI differs from the claims in the polysaccharide combination of Xanthan and a polyglucomannan polysaccharide.

FMC discloses cold melt clarified konjac glucomannan. FMC (page 8, lines 13 et seq) teaches the konjac may be mixed with selected hydrocolloids to produce synergistic results having biotechnical applications. FMC further (page 24, lines 21 et seq) teaches the konjac has multiple uses including medical technology as drug<sup>1</sup> delivery such as topical anaesthetics, antibiotic, antiseptics and the like. FMC (page 23, line 34 to page 24, line 12) teaches the ratios of konjac to hydrocolloid and give a specific example to Xanthan.

These references are combinable because they teach polysaccharides and their uses. It would have been obvious to one of ordinary skilled in the art at the time of applicants invention to employ a combination of Xanthan and konjac taught in FMC to be synergistic in the compositions of ICI which clearly contemplates numerous different hydrocolloids and the use of desirably at least one hydrocolloid (page 4, lines 11 and page 5, lines 1-6) including Xanthan.

***Allowable Subject Matter***

8. Claims 1-4, 7-8, 10-16, 19-27, 37-38, 39-43 and 52-67 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.



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9. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not disclose or fairly suggest emulsion compositions employing the concentrations of emulsifiers with the concentrations of the polysaccharide concentrations claimed. Applicants assert basis for the amendments to claim 1 and new claims 59-67 regarding the emulsifier concentrations are found throughout the specification, for example at page 5, lines 4-7 and page 6, lines 32-33. Said emulsifier has been interpreted as the emulsifier system concentration for the emulsion. Attention is further directed to the table on page 13 wherein the total emulsifier is defined as having the claimed concentrations. Said combination of the concentrations for the emulsifiers and the polysaccharide combination has been shown to have improved results of the compositions outside of the claimed limitations.

### ***Response to Arguments***

10. Applicant's arguments filed September 9, 2003 have been fully considered but they are not persuasive.

11. Applicants (page 6) assert the issues under 35 USC 112 have been obviated by amendment or are set forth in the specification. Attention is directed to the remaining issues set forth in the above rejections under 35 USC 112 above.

12. Applicants (pages 11 and 12) assert the FMC CA reference teaches plastic or solid compositions and lacks an adequate disclosure of the now claimed concentrations of the emulsifiers. Initially, the claims do not exclude creams having plasticity such as

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<sup>1</sup>Contrast with instant claim 23 which includes among other ingredients; antimicrobial components, skin care agents, and skin repair compounds.



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thixotropic compositions. Furthermore, the claims in the above prior art rejections do not define said concentrations.

13. Applicants (pages 13 and 14) assert the FMC WO reference lacks a disclosure of the now claimed concentrations of the emulsifiers. The claims in the above prior art rejections do not define said concentrations.

14. Applicants (page 11) assert a new oath/declaration is in preparation. It is noted the application can not issue without a proper declaration.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Daniel S. Metzmaier  
Primary Examiner  
Art Unit 1712

DSM